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APPL. NO.

08/895950

TO: Kerry/Ashley Pezner atty: 90F333

FAX NUMBER: 302-656-9072

PHONE NUMBER: 302-888-6259



FROM: F. Teskin

MESSAGE: copy of detailed action mailed 8/24/00

NUMBER OF PAGES INCLUDING THIS ONE: 5

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1. The response filed June 21, 2000 has been fully considered with the following effect:

(i) the enclosed copy of the declaration filed in reissue application no. 08/324,260 averring loss or inaccessibility of the original patent is acceptable in lieu of the original patent;

(ii) the prior art rejection based primarily on Japanese 62-121707 is withdrawn in view of the amendment excluding the possibility of R^3 being methyl in the three independent claims (claims 1, 7 and 19) and the comparative examples in the patent specification which demonstrate that substitution at the 2-position of an indenyl ligand as per the claimed invention has a positive and unexpected effect on the melting point of polypropylenes prepared by polymerizing with the corresponding 2-substituted metallocenes;

(iii) claims 1-15 and 19-26 are subject to new grounds of rejection under § 112 as detailed below.

2. Claims 1-15 and 19-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the following grounds for indefiniteness apply to the indicated claims.

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(A) Claims 1, 7 and 19 are inaccurate due to an obvious error in formula (I): R^7 is shown as bonded directly to R^8 instead of to the carbon atom of the $(CR^8R^9)_n$ grouping. Appropriate correction is required.

(B) Claim 19 is indefinite due to lack of definition for the variables "A" and "p" in formula (I). Appropriate correction is required.

3. Claims 1-6, 8-15 and 19-26 are rejected under 35 U.S.C. 112, first paragraph, as the specification does not contain a written description of the claimed invention, in that the disclosure does not reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the application was filed.

Specifically, the subject matter of the phrase " R^3 is ... a C_6 - C_{10} -aryl group, which is optionally halogenated" (see the definition of R^3 in claims 1, 19, 25 and 26) lacks adequate descriptive support in the patent specification. Applicants have not pointed out wherein the specification describes this subject matter and the examiner has independently found no description, express or implied, of a *halogenated* C_6 - C_{10} -aryl group as a possible choice for the R^3 substituent of the claimed compound.

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4. In view of the fact that additional errors in the original patent have been corrected through amendments to the claims and all of the additional errors corrected were not spelling, grammar, typographical, editorial or clerical errors (note, e.g., the amendment noted in item 1(ii) *supra*), a supplemental oath or declaration complying with 37 CFR 1.175(b)(1) is required. See *In re Constant*, 3 USPQ2d 1479.

5. Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 C.F.R. § 1.121(b).

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

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advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner F. M. Teskin whose telephone number is (703) 308-2456.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (703) 308-2450. The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

FMTeskin/08-20-00